

REMARKS

The specification has been amended. Claim 71 is withdrawn from consideration. Claims 34-70 remain pending in the application.

In the Office Action, claims 38, 39, 41-43, 48-53, 55, 59, 60, 62, 63, 64, 69 and 71 were indicated as withdrawn for being directed towards a non-elected species. The species selected was XII, relating to Figure 15. The Office Action states that "This invention pertains to several patentably distinct species of a thermal blanket and a plug used with the blanket. Figure 15 refers to a transverse blanket and incorporates plug (100) of Figure 1. Through the election of Figure 15, it is understood by the Examiner that the Applicant is also electing the embodiment of the plug contained in figure 1, since the plug is illustrated in Figure 15."

The withdrawal of claims 38, 39, 41-43, 48-53, 55, 59, 60, 62, 63, 64 and 69 should not be required with the election of species XII relating to Figure 15, and the Applicant respectfully requests reconsideration of this action pertaining to these claims. While Figure 15 is illustrated with plug 100, any of the disclosed plugs will equally work. Plug 100 is illustrated in Figure 15 only as an example and should not limit the plugs that can be used in Figure 15. The Specification has been amended at page 8, line 8, to correctly state that "Figure 15 illustrates one embodiment 100 in use with a conventional upper body inflatable thermal blanket 1501". The Applicant submits that "the preferred embodiment and examples shown should be considered as exemplars, rather than limitations on the present invention." (page 5, lines 11-12). Accordingly, claims 38, 39, 41- 43, 48- 53, 59, 60, 62-64, and 69 merely further characterize the plug and should not be withdrawn from consideration. The only claim that should be withdrawn is Claim 71, which is directed toward Figure 16, a non-elected species.

Claims 34 & 35 were rejected under 35 U.S.C. 102(b) as being anticipated by Dickerhoff et al. '439. That rejection is respectfully traversed for the following reasons.

Axiomatically, anticipation of a claim by a reference requires that the reference include all steps or elements, and all limitations positively recited in the rejected claim. Any recited subject matter of the claim that is omitted from, but considered to be inherent in, the reference must be shown by extrinsic evidence to be necessarily present in the thing described in the reference and so recognized by persons of ordinary skill. Finally, the anticipating reference must enable the invention of the rejected claim.

In support of the rejection it is stated that "Dickerhoff et al. disclose an apparatus for warming a person comprising an inflatable cover (10) for disposition on a portion of a person's body, two inlet ports (30, 40) in the inflatable cover and a plug (Dickerhoff, col. 3 lines 13-17) removably received in at least one port of the two ports".

It is respectfully submitted that Dickerhoff does not explicitly or inherently describe a plug according to claims 34 and 35, and does not enable the plug of these claims.

Claim 34 recites a method for controlling airflow through an inflatable device having two or more inlet ports for admitting airflow into the device which includes the following specifically-recited steps:

“providing a plug ...” (Fig. 1 of the application; not shown or described in Dickerhoff);

“placing the plug in an inlet port and retaining the plug in the inlet port ... ” (Figs 2, 15, and 16 of the application; not shown or described in Dickerhoff).

Claim 35 recites an apparatus for warming a person that includes an inflatable cover for disposition on a portion of a person's body having two inlet ports in the inflatable cover and:

“a plug removably received in at least one port of the two ports ...” (Figs. 15 and 16 in this application: not shown or described in Dickerhoff).

Dickerhoff nowhere recites a “plug” or any synonym thereof. What Dickerhoff describes is an inflatable blanket with multiple inlets, each having means “whereby such inlet may be selectively closed or opened” (Dickerhoff, col. 2 lines 26-30). Dickerhoff discloses that “the inlet ports will be initially closed by means to allow reclosing” (Dickerhoff, col. 3 lines 13-15). Dickerhoff goes on to say that such means include “an adhesive strip, double-sided tape, snaps, zippers, folding flaps, or a ziplock type seal” and in “a most preferred embodiment, the inlet ports 30,40 are initially sealed by hook and loop fastener strips VELCRO to allow easy opening and reclosing.” (Dickerhoff, col. 3 lines 13-20). None of these means, nor any of these examples, constitutes a “plug” in the sense of “an object, such as a cork or a wad of cloth, that may be used to close a gap or hole.” *Riverside Webster's II New College Dictionary*, 1986, 1995, definition of “plug” at page 848. In fact, Dickerhoff does not recite or illustrate a “plug” at all, so the omitted subject matter must be shown by extrinsic evidence to be “necessarily” in Dickerhoff and so recognized by persons of ordinary skill.

It is well-settled that the Applicant may be his own lexicographer. In this case, the Applicant has explicitly excluded all of the examples recited by Dickerhoff from the meaning of the term “plug” as it is used in this application and these claims. In this regard, see the Background of this application at page 2, lines 15-26.

While the “plug” of claims 34 and 35 is described and illustrated in detail in this application to satisfy the requirement that an invention be enabled, there is no description or illustration in Dickerhoff of any object or means for plugging an inlet port. In this regard, it is noted that, while Dickerhoff provides a verbal inventory of means and examples for reclosing, or for selectively opening and closing, the inlet ports 30 and 40, the reference nowhere describes

or illustrates those means and examples in terms of their form and construction or how they are integrated or used with inlet ports and thermal blankets. There is certainly no disclosure and illustration of the form and structure of a plug as in Fig. 1 of this application, of the operative relationship between a plug and an inlet port as in Fig. 2 of this application, or of an entire assembly constituting a plug, an inlet port, and a thermal blanket as in Figs. 15 and 16 of this application. Accordingly, Dickerhoff does not enable the invention recited in claims 34 and 35.

Furthermore, in claim 35, the "plug" (which is not described, inherent, or enabled in Dickerhoff) is limited to being "removably received in at least one" inlet port. In Dickerhoff, there is no disclosure or illustration of any object closing any inlet port that is capable of being taken away from (removed from, that is) the inlet port. The best that can be said of Dickerhoff's teaching in this regard is that the examples given are of apparatuses that are most likely to remain in or on the inlet ports permanently as integral structural parts, whatever their mode of operation (opened or closed) at any time. Thus, Dickerhoff's means to allow easy opening and reclosing that include "an adhesive strip, double-sided tape, snaps, zippers, folding flaps, or a ziplock type seal" and (in a most preferred embodiment) "hook and loop fastener strips VELCRO" are not objects that, in their common uses, are meant to be, or are capable of being, taken away from the inlet ports which they serve. Moreover, as Dickerhoff says "the inlet ports will be initially closed by means that allow reclosing." That is, according to Dickerhoff, both, or all, inlet ports have means, not "at least one" as claim 35 recites.

Accordingly, claims 34 and 35 are not anticipated by Dickerhoff, and the Applicant respectfully requests withdrawal of this rejection.

Claim 35 was rejected under 35 U.S.C. 103(a) as being unpatentable over Philpot et al. '145 further in view of Dickerhoff et al. '439. That rejection is respectfully traversed for the following reasons.

Prima facie, rejection of a claim for obviousness over a combination of references requires some motivation to combine the references, a reasonable expectation of success, and the inclusion of all elements and limitations of the rejected claim in the combination or by suggestion. See MPEP 2142, et seq.

In the Office Action it is stated that "Philpot et al. disclose an inflatable cover (10) and an inlet port (36). Philpot et al. teach all of the limitations of the claim except multiple ports and a plug removably received in at least one of the ports. Dickerhoff et al. disclose a similar device and teach that it is old and well known to provide multiple ports and a removable plug".

There is a distinct teaching away in Philpot from combination with Dickerhoff. In this regard, Philpot is directed to provision of an inlet for a thermal blanket that is located

"intermediate the blanket periphery" (Fig. 1 and Col. 1, lines 50-55), while Dickerhoff likes inlet ports to be located on the periphery, such that "one inlet port will be located on each side of the patient's head." (Fig. 1 and Col. 2, lines 65-68).

Further, placement of two reclosable peripheral ports on an end of Philpot's blanket will eliminate the prospect that Philpot's blanket will successfully avoid cooling of heated air in view of the problem identified in Philpot at Col. 1, lines 33-38. From the other point of view, the Office Action fails to identify any teaching as to how "an adhesive strip, double-sided tape, snaps, zippers, folding flaps, or a ziplock type seal" and (in a most preferred embodiment) "hook and loop fastener strips VELCRO" according to Dickerhoff can be used to successfully close the "circular opening 44" in Philpot's port 36, which is made of "stiff paper".

Finally, for reasons already set forth in detail, Dickerhoff does not disclose a "plug removably received in at least one port ...".

Accordingly, this rejection fails to meet any of the three requirements of *prima facie* obviousness and the Applicant respectfully requests its withdrawal.

Claims 36, 37, 40, 44, 45-47, 54, 56-58, 61, 65-68 and 70 were rejected under 35 U.S.C. 103(a) as being unpatentable over Philpot and Dickerhoff as applied to claim 35 above, and further in view of McCord '474. That rejection is respectfully traversed for the following reasons.

The Applicant has shown above that the rejection of claim 35 over the combination of Dickerhoff and Philpot does not satisfy the requirements of *prima facie* obviousness. McCord adds nothing to that combination that brings it into compliance with those requirements, for claim 35 or any of claims 36, 37, 40, 44, 45-47, 54, 56-58, 61, 65-68, and 70. McCord's closure is intended for use in sealing the interior of a container with a beaded lip opening against moisture damage to the container's contents. There is no showing in the Office Action whatsoever of a suggestion or teaching that McCord's closure can be adapted for closing either of Philpot's and Dickerhoff's inlet ports. Claims 36, 37, 40, 44, 45-47, 54, 56-58, 61, 65-68 and 70 all ultimately depend on allowable claim 35 and therefore should also be allowable. Accordingly, the Applicant respectfully requests withdrawal of this rejection.

Claims 35, 36, 37, 40, 44-47, 56-58, 61, 65-68 and 70 were rejected under the judicially created doctrine of double patenting over claims 2-4, 7, 11, 12, 13 and 14 of U.S. Patent No. 6,228,107. A Terminal Disclaimer is submitted with this response to overcome this rejection. Accordingly, the Examiner is requested to withdraw this rejection.

A Terminal Disclaimer fee is submitted with this paper. If the Examiner determines that any additional fee is required, the Commissioner is hereby authorized to charge any fees

necessary that may be associated with this communication, or credit any overpayment, to Deposit Account No. 50/2258.

In view of the remarks made in this paper, it is submitted that the claims are patentably distinguishable from the Dickerhoff, Philpot, and McCord references. Further, in view of the accompanying Terminal Disclaimer, it is submitted that the claims satisfy the requirements for patentability over the applicant's references which have been cited during examination. Accordingly, the application is in condition for allowance, early notice of which is respectfully requested.

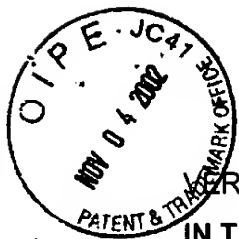
Respectfully submitted

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VERSION WITH MARKINGS TO SHOW CHANGES MADE
IN THE SPECIFICATION

Page 8, lines 8 through 11, please amend as follows:

Figure 15 illustrates one embodiment [the present invention] 100 in use with a conventional upper body inflatable thermal blanket 1501. Figure 16 shows the present invention 100 in use with a lower body inflatable thermal blanket 1601. The invention may generally be used with these and other inflatable thermal blankets.